REMARKS

Applicant respectfully requests reconsideration of the application in view of the arguments presented below.

Summary of Office Action

Claims 1-20 are pending.

Claims 1, 6, 11, and 16 were rejected under 35 U.S.C. § 101 for statutory-type double patenting in view of U.S. Patent No. 6,816,933 of Andreas ("Andreas I").

Claims 2, 7, 12, and 17 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2, 5, and 13 of Andreas I in view of U.S. Patent No. 6,148,076 of Eriksson, et al. ("Eriksson")

Summary of Amendments

The specification was amended at page 1 to reflect that the parent application has issued with U.S. Patent No. 6,816,933.

Claim 16 was amended. Support for the amendment to claim 16 can be found at page 6, lines 14-16 of the specification and Figure 3 of the drawings. Applicant submits that the claim amendment does not add new matter.

Response to 35 U.S.C. § 101 double patenting rejection

Claims 1, 6, 11, and 16 were rejected under 35 U.S.C. § 101 for statutory-type double patenting with respect to claims 3, 6, 8, 11 of U.S. Patent No. 6,816,933 of Andreas ("Andreas I"). Applicant respectfully submits that claims 1, 6, 11, and 16 of the present case are patentable under 35 U.S.C. § 101 over claims 3, 6, 8, and 11 of Andreas I. The present application will be referred to as Andreas II.

In order to sustain the statutory-type double patenting rejection, the scope of the claims must be identical. If they are of different scope, then there is

no double-patenting. A reliable test for a double-patenting rejection (statutory-type) is to determine whether the claims in one (<u>Andreas I</u>) may be infringed without infringing the claims of the other (<u>Andreas II</u>) (see, e.g., <u>In re Vogel</u>, 422 F.2d 438, 164 USPQ 619 (CCPA 1970)).

Comparing claim 3 of <u>Andreas I</u> with claim 1 of <u>Andreas II</u>, applicant notes that the scope is not identical. In particular, claim 3 of <u>Andreas I</u> can be infringed if *as few as one* of the plurality of serial devices is a SLIC. With respect to <u>Andreas II</u>, however, *each of the plurality* of serial devices must be a SLIC. Thus at a minimum, <u>Andreas II</u> requires at least 2 SLICs and every device identified with the plurality is a SLIC, while <u>Andreas I</u> only requires 1 SLIC and any other device of the plurality is not required to be a SLIC. Thus with respect to these claims there is a lack of identical scope and therefore no statutory-type double patenting.

With respect to claims 6 and 11 of the present application, applicant submits that the same argument may be made with respect to the comparisons of claims 6 and 8 of <u>Andreas I</u> with claims 6 and 11 of the present application (<u>Andreas II</u>). Applicant submits that the lack of identical scope indicates that there is no statutory-type double patenting.

With respect to claim 16 of the present application, applicant notes that *claim 16 has been amended to require that the memory, mode control, and multiplexer reside within a same integrated circuit package.* The claim of <u>Andreas I</u> identified by the Examiner (claim 11) contains no such language and thus is not limited to an integrated circuit package. Accordingly, claim 16 of the present application (<u>Andreas I</u>) has a different scope than claim 11 of <u>Andreas II</u>. Therefore there is no statutory-type double patenting with respect to applicant's amended claim 16.

Applicant respectfully submits claims 1-20 of the present application are patentable under 35 U.S.C. § 101 in view of <u>Andreas I</u> and that the statutory-type double patenting rejection has been overcome.

Response to Double Patenting Rejection (Obviousness-type)

Claims 2, 7, 12, and 17 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2, 5, and 13 of <u>Andreas I</u> in view of <u>Eriksson</u>.

Accompanying this Amendment is a Terminal Disclaimer. The Terminal Disclaimer serves to obviate the obviousness-type double patenting rejection over prior patent 6,816,933 of Andreas (i.e., <u>Andreas I</u>)

Applicant respectfully submits that the obviousness-type double patenting rejection has been overcome.

Conclusion

In view of the arguments and amendments presented above, applicant respectfully submits that all of claims 1-20 should be found to be in condition for allowance. If there are any issues that may be resolved by teleconference, the Examiner is invited to contact the undersigned at **(512) 858-9910**.

Respectfully submitted,

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